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In re Application of : DECISION ON
BARTLETT et al :
PCT No.: PCT/GB03/01641 :
Application No: 10/511,461 : PETITION UNDER
Int. Filing Date: 16 April 2003 :
Priority Date: 16 April 2002 :
Attorney's Docket No.: 13058N/041750 : 37 CFR 1.47(a)
For: Arrangement for Cooling a Roll :

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 28 November 2005. The petition fee of 130.00 has been paid.

BACKGROUND

On 16 April 2003, applicants filed international application PCT/GB03/01641, which claimed priority to an earlier application filed 16 April 2002. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 30 October 2003.

On 24 March 2003, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the Transmittal Letter.

On 22 April 2004, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date." The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it: is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. The Notice stated that the declaration must be submitted within two months from the date of this notice or 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 26 July 2005, petitioner filed an executed declaration without the signature of Mr. Corcoran.

On 23 August 2005, the USPTO mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (PCT/DO/EO/916) indicating, *inter alia*, that the second inventor Steven Phillip Corcoran did not sign the Declaration sent on 26 July 2005.

On 28 November 2005, petitioner filed the present petition under 37 CFR 1.47(a) accompanied, *inter alia*, with a declaration in support of filing on behalf of omitted inventor Stephen Phillip Corcoran.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the

refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1), and (3) of 37 CFR 1.47(a). However, requirements (2) and (4) of 37 CFR 1.47(a) has not been satisfied.

Regarding requirement (1), petitioner has provided the fee under 37 CFR 1.17(h).

Regarding requirement (2), Mr Myers stated that he telephoned Mr. Corcoran to request that he sign the declaration that was previously forwarded to him and Mr. Corcoran left a voicemail to Mr Myers that Mr. Corcoran would "not present my signature on the documents." Mr. Myers later states that on November 17, 2005 he received an e-mail from Mr. Corcoran and that following the receipt of it, Mr. Myers forwarded Mr. Corcoran another copy of the application filed in the US but Mr. Corcoran continued to refuse to sign the Declaration. However, a review of Mr. Corcoran's e-mail sent on 17 November 2005 at 2:38 pm states that it was that day he actually received the full documentation and that he has not said that he would continually refuse to sign. Also, Mr. Corcoran stated that he has not had the time to sort anything out and thus how can he decide to sign. So based on Mr. Corcoran's e-mail it can not yet be determined that he refuses to sign since it appears that he received the full documentation on November 17, 2005 and he needs time to sort out things. Moreover, the petition was filed on 28 November 2005 just less than two weeks from receiving Mr. Corcoran's e-mail. Accordingly, Mr Corcoran was not given enough time to decide to sign the required papers.

Accordingly, the current record does not support the premise that Mr. Corcoran's conduct constitutes refusal since he was not given enough time to review the documentation and to reply. Petitioner should have given Mr. Corcoran more time to response before filing the petition.

Regarding requirement (3), petitioner has provided a statement of the last known address of the missing inventor.

Regarding requirement (4), petitioner has provided a defective declaration because petitioner has not provided the necessary information about Mr. Corcoran such as his citizenship and residence on the declaration.

Consequently, at this time it can not be concluded that Mr. Corcoran has refused to sign the documents based on the evidence provided and the date the petition was filed.

DECISION

Consequently, the petition has not met the requirements under 37 CFR 1.47(a).

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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